

DEC 10 2004

PTO/SB/21 (09-04)

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

18

Application Number	09/544,150
Filing Date	April 6, 2000
First Named Inventor	PINGA, Louis J.
Art Unit	3624
Examiner Name	KARMIS, Stefanos
Attorney Docket Number	P006 P00252-US

**ENCLOSURES (Check all that apply)**

- |   |  |   |
|---|--|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input checked="" type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br><input type="checkbox"/> Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input type="checkbox"/> Other Enclosure(s) (please identify below): |
|---|--|---|

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Barlow Josephs & Holmes, Ltd.		
Signature			
Printed name	Mark E. Tetreault		
Date	December 10, 2004	Reg. No.	48,289

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Typed or printed name	Mark E. Tetreault	18 pages - via fax (703) 872-9306	Date December 10, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04)

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# **FEE TRANSMITTAL**

## **For FY 2005**

☒ Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$250.00)

**Complete If Known**

Application Number	09/544,150
Filing Date	April 8, 2004
First Named Inventor	PINGA, Louis J.
Examiner Name	KARMIS, S.
Art Unit	3624
Attorney Docket No.	P006 P00252-US

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_  
☐ Deposit Account Deposit Account Number: \_\_\_\_\_ Deposit Account Name: \_\_\_\_\_  
 For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)  
☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☐ Charge any additional fee(s) or underpayments of fee(s) ☐ Credit any overpayments  
 under 37 CFR 1.16 and 1.17

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION**
**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
20 or HP =	x	=				
HP = highest number of total claims paid for, if greater than 20						
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
3 or HP =	x	=				
HP = highest number of independent claims paid for, if greater than 3						

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other: Submission of Appeal Brief

**Fees Paid (\$)**
**\$250.00**
**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	48,289	Telephone	(401) 273-4446
Name (Print/Type)	Mark E. Tetreault	Date	December 10, 2004		

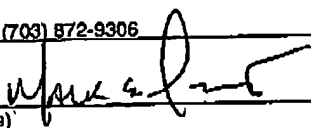
This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial No. 10/123,447

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Date:	December 10, 2004 Pages: 15

**PATENT  
ART UNIT 3624  
Serial No: 09/544,150****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	PINGA, Louis J.	)	
Serial No:	09/544,150	)	Examiner: KARMIS, S.
Filed:	April 6, 2000	)	Art Unit: 3624
Title:	CASINO BETTING, RATING AND	)	
	INVESTMENT SYSTEM	)	
Docket No:	P006 P00252-US	)	

**APPELLANT'S BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REAL PARTIES IN INTEREST**

The real party in interest is Pensino, Inc., a Rhode Island corporation, located and doing business at 55 Dorrance Street, Providence, RI 02903, sole owner of 100% interest in the subject application by assignment.

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### **RELATED APPEALS AND INTERFERENCES**

There are no related or co-pending appeals or interferences related to the appeal of this application.

### **STATUS OF CLAIMS**

Claims 1-23 are currently pending. Claims 1-23 stand as finally rejected. Claims 1-23 are being appealed.

### **STATUS OF AMENDMENTS**

No amendments were filed after the Final Rejection. The claims stand as presented under the Final Rejection.

### **SUMMARY OF THE INVENTION**

The instant invention relates to a business method for casinos to attract patrons and retain their loyalty, and more specifically, the invention relates to an investment system for casino betting wherein casino patrons can establish a casino investment account and deposit winnings or rating points into the casino investment account.

In order to maintain patron loyalty, many casinos have developed a rating system or "comp" system, wherein casino patrons are provided with a rating card, and depending on the time spent in the casino, or the accumulated amount of money bet over a period of time, the casino will award "comp" or rating points. For example, a patron may be awarded 1 rating point for every certain dollar value bet on a gaming table. Rating points are accumulated in the patrons rating account and can be exchanged for or credited towards casino services and/or goods, such as hotel accommodations, meals and souvenirs. These casino rating systems have become widespread and have been found to increase patron loyalty by giving the patron an incentive to return to the casino, i.e. to redeem points awarded at an earlier date. Typically, most casinos don't make rating points immediately available for redemption. The rating points accumulated on one visit would be available for the next visit.

In the past, when there were relatively few licensed casinos in the United States, patron loyalty was important, but not critical to casino revenues. While it was important to maintain a regular repeat customer base, the casino did not count on such repeat customers to make large profits. This was largely true because there were only so many licensed casinos and there were more than enough customers to provide all of the casinos with a sufficient customer base. However, recent dramatic increases in the number of casinos around the country has increased

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competition among casinos and there is now a push to develop systems that will maintain loyalty among regular repeat customers.

The instant invention provides a unique casino betting and rating system that allows casino patrons to deposit certain portions of rating points and/or casino winnings into special casino investment accounts that could then be transferred to a conventional financial institution investment account, such as a Mutual Fund, IRA, Roth IRA, SEP, or Keogh, as a means of increasing patron regular savings and/or retirement savings.

More specifically, patrons of a casino employing the present system will apply for a casino investment account, into which deposits can be made by various methods. For example, a selected portion of a patron's bets can be earmarked as "pension" or "investment" bets, these bets being placed on tables and paid out with differently marked chips. Any winnings from these bets could be placed into the casino investment account maintained by the casino. Alternatively, "comp" or "rating" points accumulated through normal betting could be exchanged and deposited into the casino investment account.

The casino operation can choose to establish and maintain investment services, essentially becoming a financial institution., or alternatively can establish a relationship with an existing financial institution whereby the patron's casino investment account is tied to a corresponding investment or retirement account maintained by a financial institution. These "Investment " accounts would comprise conventional IRA's, variable annuities or any other commonly available financial instrument which would accumulate interest, dividends capital gains, etc. over time and be drawn upon at a later date.

In the case of the casino establishing itself as a financial institution, the investment accounts would be invested into mutual funds, IRA's etc. at the direction of the patron.

In the case of an outside financial institution, once a certain minimum balance is reached in the casino investment account the patron could request that the amount be transferred into their "retirement account" or "investment account" at the financial institution in the same way regular businesses and individuals make deposits into investment accounts.

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### ISSUES ON APPEAL

The following issue is presented for review in this appeal:

Whether claims 1-23 were properly rejected under 35 USC §103(a) as being unpatentable over US Patent No. 6,547,131 (Foodman et al.) in view of US Patent No. 6,105,865 (Hardesty).

### GROUPING OF CLAIMS

Claims 1-23 are grouped together. Claims 2-23 stand or fall with claim 1.

### ARGUMENT

#### I. REJECTION OF CLAIMS UNDER 35 USC 103

Claims 1-23 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,547,131 (Foodman et al.) in view of US Patent No. 6,105,865 (Hardesty). The Examiner has stated that Foodman teaches a computer implemented patron betting and rating program including establishing a casino account, making a deposit into the casino account, associating the casino account with a financial institution account, and redeeming deposits from the casino account and transferring the redeemed deposits into the financial account. The Examiner further states that while Foodman does not teach that the financial accounts are investment accounts, Hardesty teaches a credit card that offers a percentage rebate that is deposited into a retirement investment account and that a combination of these two references renders the present invention obvious.

The Applicant asserts however that the process in the Foodman reference is completely the reverse of the process in the present application and is accordingly not relevant to the disclosure of the present invention. Specifically, the process and equipment in Foodman is simply operating as a glorified ATM machine. The user inserts an ATM or debit card into the machine, keys in a PIN code and requests that money be transferred into the specific machine to enable game play. The only difference between the Foodman reference and a traditional ATM machine is that the step of handing cash for the user to then take to a stand alone slot machine

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for game play has been eliminated by including the ATM functionality into the slot machine. While the ability is provided within the slot machine to then transfer remaining play credits or winnings back to the originally designated account, this is not the primary functionality of the device in that the main functionality is to enable additional player convenience by creating a direct link between the player's bank account and the machine to be played.

The present invention establishes a reserved, designated account for the benefit of a casino patron at the casino location. As the patron plays various casino games, a portion of the money wagered is then deposited into the designated account, much in the same way as rating points are accumulated. Similarly, a player may designate a portion of the winnings from wagers placed to also be deposited into the designated account. Periodically, the casino then takes the money in the designated account and transfers that money into an investment account that is maintained outside the casino on behalf of the player. This process only serves to transfer money out of the casino, there is no ability to bring money into the casino from the investment account. This can clearly be contrasted with the Foodman disclosure where money is brought into the casino using an EFT transaction and any money remaining after game play is completed can then be transferred back to the original account from which the funds were obtained. The present invention provides for the transfer of a portion of the money carried into the casino by a patron or patron winnings based on the wagering of that money to a designated retirement account. Accordingly, the Foodman reference is lacking not only in the teaching that the transfer account be an investment account but also in several other critical elements of the present invention.

The Examiner further states that the Hardesty reference is cited for the teaching that a portion of expenditures on a financial transaction may be refunded in the form of a percentage rebate into an investment account such as a retirement investment vehicle and that this teaching of an expenditure rebate into an investment account in combination with the Foodman reference above renders the present invention obvious. However, by utilizing the Foodman reference and adding the concept that the EFT account is designated as an investment account instead of an ATM or debit account only allows a patron to withdraw money for game play from an investment

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account and then to return the remaining funds back into the same account from which the withdrawal was made.

This combination still does not disclose the present invention as claimed. The present invention is not related to or concerned with where the original game play funds come from. The concept is directed at taking a designated portion of the funds wagered and winnings and segregating them into a reserve account for the benefit of the patron and then transferring those funds into an investment vehicle on behalf of the patron. If the combined disclosure of Foodman and Hardesty were to be utilized in the present invention, the game play patron would have the ability to fully access those segregated funds, bring them back into the casino for game play and completely deplete retirement funds in the investment account thereby destroying the entire retirement pension scheme disclosed in the present invention.

In other words, the combined disclosure of Foodman and Hardesty is clearly directed at providing easy and convenient access to larger fund resources in order to make it easier for a game play patron to spend larger quantities of money in the quest for the instant gratification pay off through casino wagering. Accordingly the motivation of one skilled in the art in combining these references would be the motivation to create quick and easy access to all of the resources available to a game play patron in order to have all of these resources at the patron's disposal for use in making wagers within the casino. In contrast the present invention is directed at segregating a portion of the wagered funds and removing them from the reach of the game play patron to create a forced retirement saving vehicle. This segregation of funds and removal from the reach of the patron and the casino clearly cuts against the motivation described above.

Accordingly since the teachings of the cited references alone or in combination do not disclose the limitations of the present invention as disclosed, the cited references cannot be relied upon to render the present invention. Further, as demonstrated above, since the requisite motivation necessary for one skilled in the art to combine these references teaches wholly away from stated purposes of the present invention, one skilled in the art would not be motivated to combine these references. Accordingly, this combination cannot be maintained without the



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requisite motivation for one skilled in the art to make the combination in the first place and these references cannot be relied upon for rendering the present invention obvious.

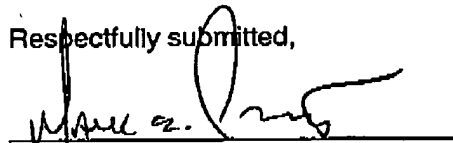
In view of the foregoing arguments, it is believed that the rejections under 35 U.S.C. §103 are overcome.

Accordingly, the Appellants respectfully solicit reversal of the final rejections and allowance of claims 1-23.

Appellants waive oral hearing.

The required fee of \$250.00 under 37 C.F.R. §1.17(f) is submitted herewith.

Respectfully submitted,



Mark E. Tetreault, Esq.  
Reg. No. 48,289

BARLOW, JOSEPHS & HOLMES, Ltd.  
101 Dyer Street, 5<sup>th</sup> Floor  
Providence, RI 02903  
(401) 273-4446 (tel)  
(401) 273-4447 (fax)  
met@barjos.com

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**APPENDIX**  
**Claims on Appeal**

1. A computer implemented method for a casino patron betting, rating, and investment program, said method comprising the steps of:

establishing a casino investment account via a computer processor, said investment account for the benefit of a casino patron;

making a deposit into said casino investment account;

associating said casino investment account with a financial investment account of said casino patron;

redeeming said deposits from said casino investment account; and

transferring said redeemed deposits into said financial investment account.

2. The method of claim 1 wherein said step of making a deposit comprises the step of depositing cash into said casino investment account.

3. The method of claim 1 wherein said step of making a deposit comprises the steps of:

establishing a formula for calculating investment rating points to be awarded to a patron during game play;

calculating said investment rating points according to said formula during patron game play; and

issuing said calculated investment rating points to said casino investment account

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wherein said investment rating points are redeemable on a monetary basis by the patron for transfer into said financial investment account.

4. The method of claim 3 further comprising the step of issuing said patron an investment rating card that is associated with said casino investment account of said patron.

5. The method of claim 1 wherein said step of making a deposit comprises the steps of:

establishing a casino system of investment betting chips;

exchanging money for said investment betting chips;

placing bets with said investment betting chips; and

redeeming said investment betting chips for deposit on a monetary basis into said casino investment account.

6. The method of claim 1 wherein said step of making a deposit comprises the steps of:

establishing a conventional rating account for the benefit of said casino patron;

establishing a formula for calculating conventional rating points to be awarded to a patron during game play;

calculating said conventional rating points according to said formula during patron game play;

issuing said calculated conventional rating points to said conventional rating account;

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redeeming at least a portion of said conventional rating points on a predetermined monetary basis for transfer into said casino investment account.

7. The method of claim 3 wherein said step of making a deposit further comprises the step of depositing cash into said casino investment account.

8. The method of claim 4 wherein said step of making a deposit further comprises the step of depositing cash into said casino investment account.

9. The method of claim 5 wherein said step of making a deposit further comprises the step of depositing cash into said casino investment account.

10. The method of claim 6 wherein said step of making a deposit further comprises the step of depositing cash into said casino investment account.

11. The method of claim 2 wherein said step of making a deposit further comprises the steps of:

establishing a formula for calculating investment rating points to be awarded to a patron during game play;

calculating said investment rating points according to said formula during patron game play; and

issuing said calculated investment rating points to said casino investment account wherein said investment rating points are redeemable on a monetary basis by the patron for

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transfer into said financial investment account.

12. The method of claim 5 wherein said step of making a deposit further comprises the steps of:

establishing a formula for calculating investment rating points to be awarded to a patron during game play;

calculating said investment rating points according to said formula during patron game play; and

issuing said calculated investment rating points to said casino investment account wherein said investment rating points are redeemable on a monetary basis by the patron for transfer into said financial investment account.

13. The method of claim 6 wherein said step of making a deposit further comprises the steps of:

establishing a formula for calculating investment rating points to be awarded to a patron during game play;

calculating said investment rating points according to said formula during patron game play; and

issuing said calculated investment rating points to said casino investment account wherein said investment rating points are redeemable on a monetary basis by the patron for transfer into said financial investment account.

14. The method of claim 2 wherein said step of making a deposit further comprises the

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steps of:

- establishing a system of investment betting chips;
- exchanging money for said investment betting chips;
- placing bets with said investment betting chips; and
- redeeming said investment betting chips for deposit on a monetary basis into said casino investment account.

15. The method of claim 3 wherein said step of making a deposit further comprises the steps of:

- establishing a system of investment betting chips;
- exchanging money for said investment betting chips;
- placing bets with said investment betting chips; and
- redeeming said investment betting chips for deposit on a monetary basis into said casino investment account.

16. The method of claim 4 wherein said step of making a deposit further comprises the steps of:

- establishing a casino system of investment betting chips;
- exchanging money for said investment betting chips;
- placing bets with said investment betting chips; and
- redeeming said investment betting chips for deposit on a monetary basis into said casino investment account.

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17. The method of claim 2 wherein said step of making a deposit comprises the steps of:

- establishing a conventional rating account for the benefit of said casino patron;
- establishing a formula for calculating conventional rating points to be awarded to a patron during game play;
- calculating said conventional rating points according to said formula during patron game play;
- issuing said calculated conventional rating points to said conventional rating account;
- redeeming at least a portion of said conventional rating points on a predetermined monetary basis for transfer into said casino investment account.

18. The method of claim 3 wherein said step of making a deposit comprises the steps of:

- establishing a conventional rating account for the benefit of said casino patron;
- establishing a formula for calculating conventional rating points to be awarded to a patron during game play;
- calculating said conventional rating points according to said formula during patron game play;
- issuing said calculated conventional rating points to said conventional rating account;
- redeeming at least a portion of said conventional rating points on a predetermined monetary basis for transfer into said casino investment account.

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19. The method of claim 5 wherein said step of making a deposit comprises the steps of:

establishing a conventional rating account for the benefit of said casino patron;

establishing a formula for calculating conventional rating points to be awarded to a patron during game play;

calculating said conventional rating points according to said formula during patron game play;

issuing said calculated conventional rating points to said conventional rating account;

redeeming at least a portion of said conventional rating points on a predetermined monetary basis for transfer into said casino investment account.

20. The method of claim 1 wherein said casino investment account is operated and maintained by said casino.

21. The method of claim 1 wherein said casino investment account is operated and maintained by an independent financial institution.

22. The method of claim 1 wherein said financial investment account is operated and maintained by said casino.

23. The method of claim 1 wherein said financial investment account is operated and



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maintained by an independent financial institution.